

### **REMARKS**

Upon entry of the present amendment, claims 1-2 and 5-10 remain pending in the above-identified application and stand ready for further action on the merits.

#### ***Amendments to Claims***

Claims 1, 5 and 8 are amended. Claim 4 has been cancelled. New claim 10 has been added.

More specifically, the upper limit for the acid value of 7.9 mg KOH/g finds support at Example 13 at Table 2. The depolymerization and/or addition reactions are described at page 16, line 13 to page 17, line 1. The lower limit of number average molecular weight is described at page 8, line 9. The upper limit of number average molecular weight is based on polyester resin P-1 at Table 1, page 50. The processability of resin film as stated at claim 1 is disclosed at page 41, line 12 to page 42, line 2. Claim 10 finds support at page 9, line 14 to page 10, line 19; page 12, line 11 to page 13, line 10; page 13, line 24 to page 14, line 1. No new matter is added by this amendment.

#### ***Rejection under 35 USC 102(b)***

Claims 1-2 and 4-9 stand rejected under 35 USC 102(b) as being anticipated by Kajimaru '669. This rejection is respectfully traversed.

By way of distinction, the reference teaches the use of acid values distinct from those recited in the claimed invention. The instant claims provide for an acid value of 2 mg KOH/g or

more and less than 7.9 mg KOH/g. By contrast, the cited reference teaches the use of an acid value of 8 mg KOH/g to 40 mg KOH/g. See the Abstract and column 2, lines 43-47 of the patent. Indeed, the acid value in the examples of the reference is 14.1 mg KOH/g or greater.

The reference thus not only fails to anticipate the claimed invention for the reasons noted above, but the reference fails to suggest the claimed invention. As shown in Comparative Examples 6 and 7, the use of a polyester having acid values of 12.1 mg KOH/g and 40.5 mg KOH/g results in inferior processability as demonstrated at Table 3, page 65 of the instant specification.

The rejection is accordingly improper and should be withdrawn.

***Rejection under 35 USC 102(b)***

Claims 1-2 and 4-6 stand rejected under 35 USC 102(b) as being anticipated by Uno '122. This rejection is respectfully traversed.

By way of distinction, the polyester of the present invention contains carboxyl groups introduced by using polybasic acids selected from terephthalic acid, isophthalic acid, phthalic anhydride, trimellitic acid or trimellitic anhydride introduced by means of depolymerization and/or addition reactions. The polyester of Uno has a terminal structure in which an alkyl group having from 4 to 20 carbon atoms or an alkenyl group having 4 to 20 carbon atoms is present.

The polyester of Uno is thus distinguishable from and does not anticipate that of the claimed invention. The rejection should accordingly be withdrawn.

***Rejection under 35 USC 103(a)***

Claims 1-2 and 4-9 stand rejected under 35 USC 103(a) as being unpatentable over Kajimaru in view of Uno. This rejection is respectfully traversed.

As shown at Table 3, page 65 of the present specification, the claimed invention exhibits highly desirable adhesion, water resistance, and solvent resistance and processability, particularly when compared to the Kajimaru reference.

As discussed above, in Comparative Examples 6 and 7, the use of a polyester having acid values of 12.1 mg KOH/g and 40.5 mg KOH/g results in inferior processability as demonstrated at Table 3, page 65 of the instant specification.

No motivation exists in the cited references to modify the Kajimaru reference in the manner asserted by the Examiner to result in the claimed invention. Indeed, it is illogical to modify the polyester of Kajimaru to have a lower acid value based on the teachings of Uno as asserted by the Examiner as such modification would change the basic character of the polyester, and be contrary to the teachings of the reference.

The Examiner accordingly fails to present a *prima facie* case of obviousness. Even if, for the sake of argument, a *prima facie* case of obviousness is stated to exist, the Examples in applicants' specification (as discussed above) overcome such a *prima facie* case of obviousness.

The rejection is thus improper and should be withdrawn.

***Double Patenting Rejection***

Claims 1-2 and 4-9 stand rejected on the ground of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,818,699 in view of Uno '122. This rejection is respectfully traversed.

In response, applicants submit that the claims as amended clearly distinguish over the claims of the cited '699 reference, such that the double patenting rejection should be found to be moot and accordingly withdrawn.

The application is accordingly believed to be in condition for allowance, and an early indication of same earnestly is solicited.

Payment in the amount of \$120.00 is submitted herewith as payment for the requested one month extension of time.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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